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PATREA L. PABST  
HOLLAND & KNIGHT LLP  
ONE ATLANTIC CENTER, SUITE 2000  
1201 WEST PEACHTREE STREET N.E.  
ATLANTA GA 30309-3400

#28

In re Application of :  
Jay D. Kranzler et al :  
Serial No.: 10/028,547 : PETITION DECISION  
Filed: December 19, 2001 :  
Attorney Docket No.: CYPR-023/01US :  
:

This is in response to the petition under 37 CFR 1.181, filed March 7, 2003, to withdraw an affidavit under 37 CFR 1.131.

#### BACKGROUND

A review of the file history shows that the examiner mailed an Office action to applicants on August 27, 2002, setting a three month shortened statutory period for reply. Applicants replied on December 27, 2002 (Certificate of Mailing Date) including a one month extension of time, an amendment to the claims and argument of the rejections of record and two identical affidavits under 37 CFR 1.131, each signed by one of the two inventors. The affidavits contain exhibits indicated as being used in a presentation prior to April 19, 2001, the date of one of the references applied in the Office action.

On March 7, 2003, applicants filed a supplemental amendment to the application and provided a new affidavit under 37 CFR 1.131 which is different from the previous affidavit. Applicants also filed this petition to have the previous affidavit removed and returned to them as the affidavit allegedly contains proprietary material.

#### DISCUSSION

One purpose of an affidavit under 37 CFR 1.131 is to allow an applicant to establish an earlier date of conception or reduction to practice of a claimed invention in order to antedate an applied reference. 37 CFR 1.131 states:

- (a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject

matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

M.P.E.P. 715 states:

#### GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. Ex parte Homan, 1905 C.D. 288 (Comm'r Pat. 1905);
- (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception. Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d). A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

#### ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

#### THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131). As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

- (A) reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his or her next succeeding action.

As noted above, affidavits are for the purpose of showing prior invention compared to the date of a reference. No provision is made for withdrawal of an affidavit once submitted.

A comparison of the affidavits submitted with the initial reply of December 27, 2002, and the affidavit submitted on March 7, 2003, shows marked differences between the two. The first affidavit alleges a date of invention prior to April 19, 2001, based on exhibits presented at a meeting prior to that date. The second affidavit alleges invention prior to some undefined date in August, 2001, based on bills from applicants' representative and draft copies of the application. The affidavit refers to exhibits A, B, C, and D, however none of these exhibits are attached, and therefor cannot be evaluated. The affidavits are clearly not commensurate in scope with each other. Obviously the second affidavit cannot, without the attached exhibits, be relied upon to antedate a reference.

Further, the Office has established a procedure for submission of confidential or proprietary information for consideration by the examiner, which information may be expunged from the record at a later date if found not to be pertinent to the determination of patentability. Information contained in an affidavit submitted to antedate a reference cannot be subject to such confidential or proprietary provisions as it does have a bearing on patentability.

## DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

**The application will be forwarded to the examiner for further consideration of the amendments filed December 27, 2002, and March 7, 2003.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll   
Director, Technology Center 1600